

REMARKS

Claims 1-4, 6-10, 18-24 and 35 were in the case prior to this amendment. Claim 1 has been amended above. Claims 1-4, 6-10, 18-24 and 35 remain in the case.

The Office Action

In the Office Action the Examiner withdrew the claim rejections made under 35 USC § 112, second paragraph. Applicants thank the Examiner for withdrawing this rejection. In addition, the Examiner renewed the claim rejections made under 35 USC § 103(a). Specifically, Claims 1-4, 8-10, 18-24 and 35 were rejected as being non-patentable over US Published Patent Application No. 20030054046 (now U.S. Patent No. 6,939,568) to Burrell et al. ("**Burrell**"). Claims 6-7 were rejected as being unpatentable over **Burrell** in view of Schonfeld et al. (U.S. Patent No. 4,646,730) ("**Schonfeld**").

In addition, the Examiner raised nonstatutory Double Patenting rejections of claims 1-4, 6-10, 18-24 and 35 as being unpatentable over claims 1-14 of U.S. Patent No. 7,135,195 in view of **Burrell**. In addition, claims 1-4, 6-10, 18-24 and 35 were provisionally rejected under obviousness-type double patenting as being unpatentable over claims 1-10 of copending U.S. Patent Application No. 11/8134081.

When allowable material is identified in the instant application, a Terminal Disclaimer in the proper form to overcome the rejection based on **Burrell** shall be filed. Applicants respectfully submit that the rejection based on copending U.S. Patent Application No. 11/813,408 is not yet ripe for action. Before a Terminal Disclaimer is necessary, allowable material will have to be identified in both pending applications. It is possible that at that time the scope of allowable claims of U.S. Patent Application No. 11/813,408 will no longer overlap with the instant application. Should it become clear

that allowable claims actually overlap, a Terminal Disclaimer in the proper form to overcome the rejection based on U.S. Patent Application No. 11/813,408 will be filed.

Claim rejections under 35 USC § 103

The Examiner renewed rejected claims 1-4, 8-10, 18-24 and 35 as being unpatentable over **Burrell**. Applicants respectfully repeat their traverse of this finding. As stated in the immediately previous amendment, Applicants greatly appreciate the careful manner in which the Examiner has laid out the Graham factors. As detailed below, Applicants still disagree with the Examiner's use of the factors. However, the Examiner is to be commended for carefully and clearly responding to Applicants' arguments. This is tremendously beneficial to Applicants and significantly improves the undersigned attorney's understanding of the Examiner's position.

In the Response to Arguments on page 6 of the Office Action the Examiner indicated that Applicants are arguing that because the Examiner had not clearly determined the level of ordinary skill in the art, it is not possible to demonstrate that the differences between the claimed invention and the prior art were such that one of ordinary skill would have had a reasonable expectation of success. Perhaps this statement is a way of stating Applicants' point, but for clarity Applicants will respectfully repeat their argument in a slightly different form. Applicants agree with the Examiner that the person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. Applicants' also concur with the Examiner's quotation of *KSR International Co. v. Teleflex Inc* ("**KSR**"): "A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." This means the person of ordinary skill in the art while "magically" aware of ALL of the RELEVANT art is reasonably clever but not a genius or omniscient. Applicants' believe that the Supreme Court's position in **KSR** was based on the conclusion that the patented gas pedal was only modestly different from prior art devices so that great

creativity was not needed to make a reasonable prediction of success even though no teaching, suggestion or motivation was provided in the prior art. In **KSR** the invention was mechanical/electromechanical which is considered a highly predictable area of art so that there was little or no argument concerning the level of skill in the relevant art.

However, the present invention is clearly not a simple mechanical one. That is one reason why it is so essential to determine clearly the RELEVANT area of art because this controls the predictability of the art. The more predictable the art, the less information one of ordinary skill requires to have a reasonable expectation of success. In **KSR** the art was predictable so that the claimed invention was determined to be obvious—that is one of ordinary skill would have had a reasonable expectation of success in making the combination. Applicants respectfully suggest that the present art is considerably less predictable than the mechanical arts. One of ordinary skill would inherently have less of a reasonable expectation in success. Thus, to have a reasonable expectation of success, the prior art must provide a greater degree of guidance.

Applicants respectfully disagree with the Examiner's conclusions (top of page 7 of the Office Action) that **Burrell** teaches a range of silver (1-5000 ppm) to be suitable. Applicants respectfully contend that the RELEVANT art for the present invention is that of antimicrobial silver and particularly that of antimicrobial silver particles. As explained both in the specification and in the immediately previous amendment, there is tremendous variability in the antimicrobial properties of various silver particulate materials. Applicants respectfully contend that one of ordinary skill in the art would know this and would have little or no expectation of success unless the prior art provided some data to support empty pronouncements. Applicants note that the range of 1-5000 pm is mentioned in paragraphs [0054] and [00165] of **Burrell** but there is absolutely no support for the effectiveness of the silver products over these ranges. In fact, there is no clear indication as to what form the silver is in. The application talks about silver powder

and “silver solution” eluted from a silver containing bandage. No where is it clearly indicated what form the silver in the cited paragraphs takes. Paragraph [0186] indicates that silver at 85 ppm can be solubilized under acid conditions, but it is not clear what form this silver is in—it could be ions, it could be particles (what size?) or it could be active atomic clusters (defined as being much smaller than the particles of the instant invention).

The instant application clearly specifies silver particles with a particular composition and having a defined size range. The silver of the present invention is clearly demonstrated to have significant antimicrobial properties at a very low silver concentration. There is no indication in **Burrell** that the silver material disclosed is effective at such low silver concentrations as the present invention. Because the person of ordinary skill in the art would be fully aware of the variable and unpredictable nature of silver products, the person of ordinary skill in the art would have no reasonable expectation that the silver product of the present invention would show the unusual properties that it does. The point of supposed overlapping ranges is inapposite. There is no support in the prior art for effectiveness of silver particles at the lower portions of that range. One of ordinary skill in the art is “not an automaton.” The person of ordinary skill in the art of antimicrobial silver and particularly that of antimicrobial silver particles would not act like a robot and waste his or her time formulating a silver composition at concentrations below any demonstration of effectiveness since there would be no reasonable expectation of success.

The experiments presented in the instant application show that silver particles of a particular composition and size range are clearly effective at extremely low concentrations. However, **Burrell** does not teach silver particles having the size and composition of the instant invention. Nor is there anything in **Burrell** to suggest to one of ordinary skill in the art that making silver particles with the composition and size of the instant invention would provide these unusual properties. Applicants respectfully

contend that the differences between their invention and the prior art include the use of silver particles having a certain defined range and having a structure wherein the core of the particle is metallic silver and the entire surface of the particle is coated with silver oxide. Applicants respectfully contend that nothing in the prior art would lead one of ordinary skill in the art to make such a composition.

In the Response to the Argument (page 7 of the Office Action) the Examiner indirectly admits that the prior art does not teach silver particles having a core of silver and a coating of silver oxide. The Examiner points out that the claims call only for a "surface" of silver oxide and that "there is nothing in the claims that limits the exterior of the particles to be only silver oxide." The Examiner goes on to interpret the claims as requiring only a portion of the surface of the particle to be silver oxide. It has always been the intent of the Applicants to claim particles wherein the entire surface is coated with silver oxide (see paragraph [34] describing a coating of silver oxide and paragraph [59] describing the analysis of a silver oxide surface coating). However, the Examiner is correct that it is possible to interpret the claim language otherwise particularly in light of **Burrell**. Therefore, claim 1 has been amended to unambiguously claim a silver particle having a surface coating of silver oxide. Applicants respectfully contend that the prior art does not render obvious silver particles having such properties. In light of the cited prior art one of ordinary skill in the art would have not reasonable expectation that silver particles having a surface coating of silver oxide and falling in the claimed size ranges would show significant antimicrobial properties at the low overall levels of silver specified in the claims.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested. If for any reason the Examiner still finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (310) 229-9928 to discuss the steps

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necessary for placing the application in condition for allowance. You are hereby authorized to charge any fees due and refund any surplus fees to our Deposit Account No. 22-0261. Please reference matter number 80663.251821.

Respectfully submitted,

VENABLE LLP

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